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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/071,938

02/07/2002

Robert John Mulligan

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MOTOROLA INC
600 NORTH US HIGHWAY 45
ROOM AS437
LIBERTYVILLE, IL 60048-5343

EXAMINER

CHIANG, JACK

ART UNIT

PAPER NUMBER

2642

DATE MAILED: 10/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/071,938	Applicant(s) MULLIGAN ET AL.	
	Examiner Jack Chiang	Art Unit 2642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-34 and 40-50 is/are pending in the application.
- 4a) Of the above claim(s) 17-25 and 35-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-34 and 40-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

by

RESTRICTION

1. Claims 17-25 and 35-39 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention/species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 8/19/05.

Claims 17-25 and 35-39 had been withdrawn;

Claims 26-34, 40-50 are examined.

CLAIMS

112 First Paragraph Rejection

2. Claims 26-34, 40-50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. See comments below.

Claims 26-34, 40-50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claims 26, 29, 32, 34 and 40, they all recited "non-visual sensation". This is questionable and contradicting the original disclosure which stated that it has "visual"

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effects in pages 2, 13-15 of the original disclosure. Therefore, it is considered as unenabling and possibly a new matter.

Art Rejection

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 26-34, 40-50, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Lehtiniemi et al. (US 6466299).

Regarding claim 26, Lehtiniemi shows a housing (fig. 1) comprising:

An outer surface (C) which includes a sensory producing substance (A1-A4) producing at one “*non-visual*” (see also 112 rejection above) sensation responsive to at least one stimulus (col. 1, lines 58-67).

Regarding claim 29, Lehtiniemi shows a housing (fig. 1) comprising:

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An outer surface (C) including at least one shape element (see A1-A4) which includes a sensory producing substance (A1-A4) that produces at one "*non-visual*" sensation responsive to at least one stimulus (col. 1, lines 58-67).

Regarding claim 32, Lehtiniemi shows a housing (fig. 1) comprising:

An outer surface (C) including at least one shape element (see A1-A4) that includes a sensory producing substance (A1-A4) that produces at one "*non-visual*" sensation responsive to at least one stimulus generated by a plurality of internal components (col. 1, lines 58-67).

Regarding claim 34, Lehtiniemi shows a housing (fig. 1) comprising:

An outer surface (C) which includes a sensory producing substance (A1-A4) that produces at least one adjustably, "*non-visual*" sensation responsive to at least one stimulus (col. 1, lines 58-67, col. 4, lines 20-58).

Regarding claim 40, Lehtiniemi shows a housing (fig. 1) comprising:

An outer surface (C) including at least one shape element (see A1-A4) which includes a sensory producing substance (A1-A4) that produces at least one "*non-visual*" sensation responsive to one or more operation of a plurality of internal components (col. 1, lines 58-67, col. 4, lines 20-58).

Regarding claims 27-28, 30-31, 33, 41-50, Lehtiniemi shows:

The housing (fig. 1);

The sensory producing substance is a combination of one or more substances selected from a group comprising a thermal producing substance, a vibration producing substance, and a haptic producing substance (col. 1, lines 58-67);

The sensory producing substance causes the housing to provide to a user one or more sensations selected from a group comprising heat, pressure, and texture (col. 1, lines 58-67, col. 2, lines 3-14);

The stimulus is a combination of one or more stimuli selected from a group consisting of an acoustic, a thermal, an electrical, an electromagnetic, an olfactory, and a mechanical stimulus (col. 1, lines 58-67);

The one or more operations is selected from a group comprising a light from a keypad, light from a display, a vibration from an alerting mechanism, an audible alert from a speaker (col.1, lines 66-67, col. 4, lines 39-46, col. 8, lines 16-19).

ARGUMENT

5. In response to the remarks filed on 08/19/05 (pages 20-26), in pages 22-24, applicant mainly argues about "non-visual" sensation. This issue has been addressed above, including the 112 and art rejections, see comments above.

6. Applicant's arguments with respect to claims 26-34 and 40-50 have been considered but are moot in view of the new ground(s) of rejection.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

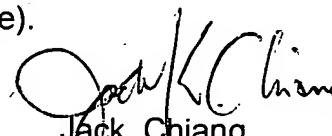
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Chiang whose telephone number is 571-272-7483. The examiner can normally be reached on Mon.-Fri. from 8:00 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 571-272-7488. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jack Chiang
Primary Examiner
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